

### REMARKS

In the Advisory Action dated September 17, 2004, claims 86-99 were presented for examination. Claims 86-99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Waits et al.* in view of *Gisby*.

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application.

**I. 35 U.S.C. §103(a) - Unpatentable over *Waits et al.* in view of *Gisby***

Claims 86-99 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Waits et al.*, U.S. Patent No. 5,721,831 in view of *Gisby*, U.S. Patent No. 6,118,865.

The comments pertaining to both *Waits et al.* and *Gisby* in response to the Second Office Action are hereby incorporated.

Applicant has amended claim 86 to further define the invention over the prior art of record. More specifically, claim 86 has been amended to incorporate the language of claim 91. As noted by the Examiner in the Second Office Action, *Waits et al.* does not explicitly disclose this limitation. The Examiner suggests that *Gisby* provides this limitation, and cites Col. 7, lines 27-42, and Col. 2, lines 50-67. However, after careful review of both of these cites, as well as the entire *Gisby* patent, it is clear that *Gisby* does not institute a time interval in which a lead must have received marketing effort.

In addition to amending claim 86, Applicant has added claims 100-123 to further define the invention over the prior art of record. More specifically, claim 100 includes all of the limitations of original claim 86 with additional language pertaining to communication of an alert in response to a neglected lead. Similarly, claim 111 includes all of the limitation of original claim 86 with additional language pertaining to moving a lead to a station, wherein the station may include a selection of three locations. The additional language of claim 100 includes the limitations of original claim 92. As noted by the Examiner in the Second Office Action, *Waits et al.* does not explicitly disclose this limitation. The Examiner suggests that *Gisby* provides this limitation, and cites Col. 7, lines 27-42, and Col. 2, lines 50-67. However, after careful review

of both of these cites, as well as the entire *Gisby* patent, it is clear that *Gisby* does not institute sending a communication to a user in response to neglect of a lead. Rather *Gisby* uses an "automated auto-dialer" to place a call to try to regain communication with a lead. See Col. 7, line 29. *Gisby* sends a communication to a caller not to a user, as claimed by Applicant. Similarly, the additional language of claim 111 includes the limitations of moving a lead to a station, wherein the station may include three options for selection. Support for the one additional option may be found in the Specification, page 24, line 11. Although *Gisby* teaches a telecommunication tool for moving a survey customer from one station to a subsequent station, *Gisby* does not support allowing the lead to remain in a specific station. See Fig. 2 of *Gisby*.

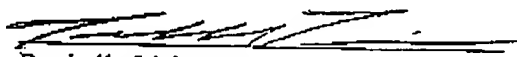
"Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d 1430 (Fed. Cir. 1990)). *Waits et al.* does not suggest moving a lead to a subsequent station, and although *Gisby* teaches moving a survey participant to one of two stations, *Gisby* does not teach or suggest use of a time interval associated with movement of a participant, communication of an alert to a user for a neglected lead, or selection among three options for moving a lead in the workflow. To read *Gisby* as providing the structure that supports any of these three noted differences would require a modification to the invention of *Gisby* not envisioned or taught. The only suggestion for a system that utilizes any of these three noted differences is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within the combination of *Waits et al.* and *Gisby* for such a modification. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. Accordingly, the combination of the prior art references is improper as the Examiner's combination is precipitated by utilizing Applicant's claimed invention as the template to make the modifications suggested by the Examiner, which by its very nature makes such a combination non-obvious.

The teaching, suggestion, or motivation for combining the references must emanate from the references themselves, and not from Applicant. The prior art must teach the desirability of the modification in question. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There is no desire within the references themselves to combine the elements of the prior art to arrive at Applicant's invention. The desirability can be found at best only through the use of Applicant's invention. Therefore, the prior art references whether taken individually or in combination do not render Applicant's invention obvious as there is no teaching, suggestion, or motivation to combine the elements found in different prior art references having different purposes to build the product of Applicant. Accordingly, Applicant respectfully contends that the combination of *Waits et al.* and *Gishby* does not meet the standard set by the CAFCs interpretation of 35 U.S.C. §103(a), and respectfully requests allowance of claims 86,87, 89, 90, 92, 94-123.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,

  
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The transmission ends with this page  
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